

MAILED

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UNITED STATES PATENT AND TRADEMARK OFFICE
 BEFORE THE COMMISSIONER OF PATENTS AND TRADEMARKS

In re _____)
) Decision on Petition
) under 37 CFR § 10.2(c)
)

This is a decision on a petition dated April 26, 1991,
 by _____ (petitioner) under 37 CFR § 10.2(c).
 Petitioner requests review of the decision of the Director of
 Enrollment and Discipline, entered March 28, 1991, refusing to
 register petitioner to practice before the Patent and Trademark
 Office.

The Director's decision was on a request for regrade of
 Questions 1, 2 and 3 of the afternoon section of the
 examination for registration held on October 10, 1990. The
 Director added fourteen points to petitioner's score of 52 on
 the afternoon section, thus giving petitioner a score of 66.

BACKGROUND

Petitioner's ground for challenging the Director's
 decision is that more points should have been added for each of
 his answers to Questions 1, 2 and 3. Petitioner requests that
 sixteen more points be added to his score, which would give him
 a passing grade of 82. A minimum of four more points, however,
 would be sufficient to give petitioner a passing grade of 70
 (out of 100).

Question 1, worth 30 points, was drawn to claim drafting.
 The Question presented three options -- A, B or C. Petitioner
 chose Option A. Petitioner originally received nineteen points

for his answer. The Director's decision added five more points, for a total of 24. Petitioner requests that four more points be added.

Question 2, worth 30 points, was drawn to drafting an Information Disclosure Statement. Petitioner originally received nineteen points for his answer. The Director's decision added one more point, for a total of 20. Petitioner requests that four more points be added.

Question 3, worth 40 points, was drawn to drafting the necessary documents in response to an Office action. Petitioner originally received fourteen points for his answer. The Director's decision added eight more points, for a total of 22. Petitioner requests that eight more points be added.

FACTUAL REVIEW

Question 1, Option A

Question 1, Option A, sets forth a description and visual illustration, with six figures, of a safety hook. To the extent relevant here, the safety hook contains a link, a J-shaped hook member and an R-shaped latch member. The link contains a hole to receive a cylindrical pin which is part of the J-shaped hook member and which permits the link to rotate freely about the cylindrical pin axis. The J-shaped hook member has a head and a J-hook and a mouth inbetween. Within the head is a recess with side walls containing pivot holes. The R-shaped latch member, which contains pivot pins, is pivotally seated in the recess via the pivot pins in the pivot

holes. The R-shaped latch member also contains a locking arm and a resilient arm. In the normally closed position of the safety hook, the resilient arm is seated in a notch within the recess.

Question 1, Option A, requires the drafting of a single picture claim drawn to the safety hook. The instructions for Question 1 state, inter alia, that points will be deducted for using language which is indefinite or does not have antecedent basis, or for failing to interrelate and/or include required elements or components or steps.

One point each was deducted from petitioner's answer, respectively, for

- (1) not positively locating the hole on the link, in connection with the recital in petitioner's claim that "[s]aid pin is disposed through an open-linking area forming a hole, whose diameter is greater than the diameter of said pin, permitting the said link to be retained on and rotate freely about the said cylindrical pin axis,"
- (2) failing to recite that the mouth of the J-shaped hook member is between the head and the J-hook, in connection with the recital in petitioner's claim that "[s]aid J-shaped hook member has a head and a mouth between the said head and said J-shaped hook member,"
- (3) lacking antecedent basis, in connection with the

recital in petitioner's claim "the side walls," and
(4) lacking antecedent basis, in connection with the
recital in petitioner's claim "said notch."

The Director found that the deduction of one point for each of the above items (1) through (4) was proper.

With regard to item (1), the Director found that the claim language is vague and does not clearly define the location of the hole, or as petitioner states, the "open linking area."

With regard to item (2), the Director found that the recital was incorrect, and that the term "[s]aid J-shaped hook member" should have been the J-hook.

With regard to items (3) and (4), the Director found that a sidewall is a structural term and as such must be properly set forth in the claim. The Director further found that it is incorrect to state "the" or "said" in reference to a structure that has not previously been set forth in the claim.

Petitioner requests addition of one point for each of items (1) through (4), for a total of four points.

Question 2

Question 2 sets forth information, all of which is stated to be material to a patent application claiming a novel sintered ceramic composition. The information includes a description of prior art including a patent, a printed publication, offers for sale, and completed sales. The Question requires the drafting of an Information Disclosure Statement (IDS) from the information set forth. The

instructions for Question 2 state, inter alia, that the IDS must comply with all requirements of PTO rule provisions and include information which "should" be included in the IDS under the rules.

Nine points were deducted from petitioner's answer for not discussing the references cited as to their relevance in materials and utility. An additional one point was deducted for omitting "pertinent page 90" of a particular reference. Petitioner's answer states, in pertinent part:

All of the patents and publications listed are related to ceramic products and processes. In general; however, none of these patents, publications, or on sale information disclose exactly the inventive concepts claimed in this application.

The Director found that the deduction of nine points was proper. He found that the requirements for an IDS are clearly set forth in 37 CFR § 1.98 and that petitioner should have provided a concise explanation of the relevance of each item of prior art. According to the Director, a generalized statement that the references are related to ceramic products and processes does not satisfy this requirement.

Petitioner requests that three of the nine points deducted for not discussing the relevance of the cited prior art references be added back. Petitioner requests further that the one point deducted for omitting reference to page 90 be added back.

Question 3

Question 3 sets forth information about a novel hook fastening device for a clothesline. The device provides solutions to the problem of fastening a coat hanger to a clothesline. The device attaches to a clothesline and a coat hanger hook, and has an upper jaw, a lower jaw, and a coil spring that closes the upper and lower jaws. The inventor has filed a patent application fully disclosing two embodiments of his invention. In the preferred embodiment, the lower jaw has two spaced-apart branches that straddle the coat hanger hook and press upward against the bottom of the clothesline. At the same time, the single member upper jaw presses the coat hanger hook downward against the clothesline, resulting in the hook and clothesline being clasped together to prevent the hook from moving along the clothesline or blowing off the clothesline. In the non-preferred embodiment, both lower and upper jaws have two spaced-apart branches that straddle and reach past the coat hanger hook to clasp the clothesline. This embodiment does not clasp the hook itself and is therefore less effective than the preferred embodiment. The non-preferred embodiment was disclosed by the inventor in an article published in the French Clothespin Journal. The patent application contains three claims. Independent claim 1 is drawn to a device for fastening a coat hanger hook to a clothesline comprising upper and lower jaws and a closing member for urging the two jaws toward a closed clasping position. Claim 2 depends from claim 1 and is

drawn to the preferred embodiment. Claim 3 depends from claim 1 and is drawn to the non-preferred embodiment. The inventor has received an Office action. Claim 1 was rejected under 35 U.S.C. 102(a) as anticipated by a common spring clothespin. Claim 2 was rejected under 35 U.S.C. 103 as obvious over the device disclosed by the inventor in the French Clothespin Journal article. Claims 1 and 3 were rejected under 35 U.S.C. 102(b) as anticipated by the device in the Journal article. The response is due today. The inventor is a citizen of France. He does not have a birth certificate but his French passport shows that he was born on July 3, 1905.

Question 3 requires the drafting of all necessary documents to properly respond to the Office action and to pursue the inventor's expressed desire to advance and accelerate the prosecution of his patent application. The instructions state, inter alia, that no credit will be given for any answer or notes merely explaining what course of action should be taken to respond to the Office action.

In his answer to Question 3, petitioner filed an amendment cancelling claims 1 and 3 and amending claim 2. Amended claim 2 reads as follows:

[The device of claim 1] A device for fastening a coat hanger to a clothesline wherein [the lower jaw has two spaced-apart branches and the upper jaw is a single solid member] The upper and lower jaws each have two spaced-apart branches engaging and pressing

a hook of a coat hanger downward against a clothesline thereby clasping the hook and clothesline together.

In his "Remarks" section, petitioner states with respect to the amendment to claim 2:

Claim 2 as amended overcomes the examiner's 35 USC 103 obvious rejection to the French Clothespin Journal article by citing upper and lower jaws with 2 spaced-apart portions.

At the end of his answer, petitioner states: "(Note:) Special processing by PTO; applicants advanced age. Application made 'Special'."

Four points were deducted from petitioner's answer for his amendment to claim 2, in that the claim still reads on the French Clothespin Journal.

The Director found that the deduction was proper. He noted that the amended claim recites no structure that can accomplish the desired result of preventing the hook of the hanger from moving along or blowing off the clothesline. In particular, no means has been claimed for pressing the hook against the clothesline. The claim contains no more structure than that already disclosed in the French Journal and therefore, the rejection over the French Journal has not been overcome regardless of the functional language added to the claim.

Petitioner requests that two points be added back to his

score for his amendment to claim 2.

Eight points were deducted for not presenting arguments as to why the claim 2 subject matter would not have been obvious.

The Director found this deduction to be proper. The Director pointed out that the requirements for a proper response to an Office action are set forth in 37 CFR § 1.111(b). Petitioner's remarks did not patentably distinguish the claimed invention over the cited prior art and did not address why it would not be obvious to modify the prior art. According to the Director, a generalized statement that the amended claim overcomes the obviousness rejection does not satisfy this requirement.

Petitioner requests that four points be added back to his score for statements under "Remarks."

Eleven points were deducted for the statement at the end of the answer "(Note:) Special processing by PTO; applicants advanced age. Application made 'Special'" on the ground that no credit can be given for merely explaining what should be done.

The Director added back five points from the eleven deducted, in view of petitioner's argument that he included a copy of the inventor's passport as evidence of age.

Petitioner requests that two additional points be added back to his score for the statements about the applicant's advanced age and making the application special.

DECISION

Question 1, Option A

I find no error in the deduction of one point for each of items (1) through (4) in the discussion of Question 1, Option A, supra.

With regard to the deduction for not positively locating the hole on the link, petitioner argues that in his recital of the claim, the hole location is implied to be on the link and could be no where else. I don't agree.

Petitioner's recital calls for the pin to be disposed through an "open linking area" forming a hole. The quoted term appears nowhere in the Question. The "open linking area" could be part of the link, or it could be a separate element -- next to the link, for example. The quoted term is indefinite.

With regard to the deduction for failing to recite that the mouth is between the head and the J-hook, petitioner argues that the J-hook and the J-shaped hook member are ambiguous in terminology and could be easily interposed in relating to Figure 1. Petitioner appears to be arguing that he used the second recital of the term "J-shaped hook member" in place of the intended "J-hook." In other words, petitioner appears to be arguing that he meant to recite "[s]aid J-shaped hook member has a head and a mouth between the said head and said J-hook."

No points will be credited for petitioner's intentions. Nevertheless, petitioner's intended recital is also defective. Since petitioner's claim as drafted does not recite the J-hook

element, the term "said J-hook" would have had no antecedent basis. Nor are the terms ambiguous. It is clear from the Question that the J-hook is one element of the J-shaped hook member.

With regard to the deduction for lacking antecedent basis in the recital of "the sidewalls," petitioner argues that no antecedent basis is required for sidewalls in view of the term "the sidewalls" appearing in the "specification" for Question 1 and in view of 35 U.S.C. 112, paragraph 6.

It is not clear what petitioner means by "specification" but the fact that the Question uses the term "the" preceding "sidewalls" with regard to the recess does not mean that the term "sidewalls" does not require antecedent basis in the claim. A recess can have many different configurations. A recess of circular cross-section, for example, would have no sidewalls. Nor does the sixth paragraph of 35 U.S.C. 112 have any relevance to the issue of antecedent basis. That paragraph allows for means plus function language in claims. The instructions to the Question explicitly forbid describing any of the required elements in terms of means plus function.

With regard to the deduction for lacking antecedent basis in the recital of "said notch," petitioner argues that "notch" does not require antecedent basis because a notch is not described as one of the elements in the "specification" and further, that he intended to recite "a" notch.

The notch is an element of the claimed invention by virtue

of its existence and function. The deduction was proper for the reasons stated by both the grader and the Director.

Question 2

I find no error in the deduction of ten points for Question 2.

With regard to the deduction of nine points for not discussing the relevance of the cited references, petitioner requests that three points be added back in that he discussed their relevance by stating they were "related to ceramic products and processes" and in that he incorporated by reference, pursuant to Manual of Patent Examining Procedure (MPEP) § 608.01(p), one of the items of prior art by citing the stock number of a product which the owner of the patent application sold. The Question includes information describing the composition, properties and utility of the product having that stock number. Petitioner claims that he incorporated by reference because he did not have time to copy the information directly.

As the Director correctly found, a generalized statement that the references relate to ceramic products and processes does not comply with 37 CFR § 1.98, the operable rule on IDSs. Such a statement is entitled to no credit.

As to the argument about incorporating by reference and not having enough time, petitioner's citation to MPEP § 608.01(p) is misplaced. That section refers to incorporation by reference in a patent application as filed.

There is no provision for incorporation by reference in an IDS.

Moreover, there is no indication in petitioner's answer that the term "(REF) CAC Stock No. 12-345" was intended to be the equivalent of the product composition, property and utility information set forth in the Question and that the quoted phrase was used instead because of lack of time. Lack of time to complete an answer, nevertheless, is not an acceptable excuse.

It is pointed out that the instructions to Question 2 state that no credit will be given for any answer or notes which merely explains what the IDS will or should contain. At best, the matter asserted by petitioner to be an incorporation by reference is a mere explanation of what the IDS will or should contain.

Even if petitioner's reference to the stock number was acceptable, it is noted that his answer separates as items 2) and 3) the offer for sale and the sales themselves. Item 2) lists the offer for sale and seven sales. Item 3) lists one sale. The matter which petitioner asserts to have been incorporated by reference refers only to item 3). It would still be unclear from petitioner's answer that the offer for sale, the seven sales and the sale in item 3) were all of the same product.

With regard to the issue of the deduction of one point for omitting the reference to page 90 of a reference, petitioner did not raise this issue with the Director. The Director's

decision will not be reviewed on grounds not raised before the Director. It is noted, however, that if the matter had been raised with the Director, the Director would have been justified in refusing to add back one point. Contrary to petitioner's argument, his answer refers only to page 95 of the reference. Page 90 is the only page of the reference which mentions utility.

Question 3

I find no error in the deduction of points for Question 3.

With regard to the deduction of four points for the amendment to claim 2, petitioner essentially repeats the same argument he made before the Director. The Director correctly refused to add back any points. The Question states that two embodiments of the invention have been disclosed. Petitioner's amended claim 2 is drawn to neither of these embodiments. That is, no embodiment is disclosed where (1) both the upper and lower jaws have two spaced-apart branches and (2) both the hook and the clothesline are clasped by the device. Indeed, petitioner's amended claim 2 would have been properly rejected for failing to comply with both the description and enablement requirements of 35 U.S.C. 112.

With regard to the deduction of eight points for not presenting arguments as to why the claim 2 subject matter would not have been obvious, petitioner makes a number of arguments. These arguments are, in essence, (1) that his answer complies with 37 CFR § 1.111(b) and MPEP § 714.02; (2) that his answer

could be considered a bona fide attempt to advance the case to final action but through inadvertence or oversight some point necessary to complete the response was omitted; (3) that time limits did not permit him to develop additional arguments directed to why claim 2 was not obvious; and (4) that the deduction of eight points is too many, since the model answer apportions eight points to the Remarks section while the argument for why claim 2 is not obvious is only part of the requirements of the Remarks section.

The last sentence of 37 CFR § 1.111(b) states:

A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

Petitioner's answer does not comply with this rule. Indeed, it states that amended claim 2 recites upper and lower jaws with two spaced-apart portions, which is precisely the feature disclosed in the French Clothespin Journal!

Nor could petitioner's answer be considered to have an inadvertent oversight or omission, since the answer does address the ground of the rejection of claim 2 over the French Clothespin Journal.

With respect to insufficient time to develop additional arguments, petitioner's answer, in essence, contains no arguments directed to why claim 2 was not obvious. Moreover,

as stated above, insufficient time to complete an answer is not a valid excuse.

That petitioner was credited with none of the eight points apportioned to the Remarks section in the model answer is justified since pursuant to a proper amendment, only one issue needed further discussion. That issue was the patentability of amended claim 2 in view of the French Clothespin Journal. Pointing out in the Remarks section what is already self-evident -- that claims 1 and 3 have been cancelled and that reconsideration and allowance of amended claim 2 is requested -- does not entitle petitioner to additional credit.

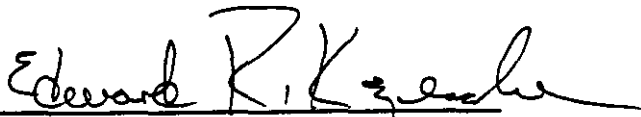
With regard to the deduction of eleven points for merely explaining what should be done in the statement at the end of the answer "(Note:) Special processing by PTO; applicants advanced age. Application made 'Special'," petitioner notes that the Director added back five points and argues further that he is not merely explaining what should be done. Petitioner further argues that he did not have enough time left to write a formal petition for special examination.

The above-quoted statement is not a petition to make special, nor does it evince petitioner's knowledge that a petition must be filed in order to obtain special status. At most, it shows petitioner's knowledge that advanced age is a valid ground for obtaining special status. Indeed, the statement is even less than a mere explanation of what course of action should be taken, since it does not state that a

petition need be filed. It is noted that petitioner earlier in his answer made a statement referring to filing, inter alia, an "[a]pplication" and a copy of the inventor's French passport. If by "application" petitioner meant "petition", this earlier statement, too, is nothing more than a mere explanation of what course of action should be taken. With regard to a lack of time, as stated above, it is not a valid excuse. Petitioner is entitled to no more points on this ground.

CONCLUSION

No points have been added to petitioner's regraded score of 66. The Director's decision of March 28, 1991, is affirmed. Therefore, this petition is denied.


EDWARD R. KAZENSKE
Executive Assistant to the
Commissioner of Patents
and Trademarks